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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/606,925	06/29/2000	James P. Rodrigues	MS #154645.1/40062.69-US-	6703
23552	7590	11/13/2003	EXAMINER BARAN, MARY C	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			ART UNIT 2857	PAPER NUMBER

DATE MAILED: 11/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/606,925

Applicant(s)

RODRIGUES ET AL.

Examiner

Mary Kate B Baran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-27 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5 is/are rejected.
- 7) ☒ Claim(s) 4 and 6-12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

## **DETAILED ACTION**

### ***Response to Amendment***

1. The action is responsive to the Amendment filed on 20 August 2003. Claims 1, 5, 9, 10, 13, 15, 16, 21 and 28 are pending. Claims 1, 5, 9, 10, 13, 15, 16 and 21 have been amended. Claim 28 is new.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending Application No. 09/606896 ("the '896 application").

Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 1 of the instant application recites: a computing system having a mass storage device and a system timer for obtaining benchmark timing for a portion of an

application program execution, having a mass storage system, an init module for determining if the timestamp data is to be collected during the operation of the application program, a performance marker module for obtaining and storing the timestamp data for later retrieval, an uninit module for formatting and storing the obtained timestamp data into a data file within the mass storage device that permits retrieval after the termination of the application program, and a performance benchmark data post processing module for determining the benchmark timing from two or more timestamp data entries, wherein an init module is executed before timestamp data is collected, a performance marker module executed each time benchmark timestamp data and overhead timestamp data is to be collected, an uninit module is executed after all timestamp data desired has been collected, and a performance benchmark data post processing module which determines the benchmark timing from timestamp entries stored within the data file.

Claims 1 and 2 of the '896 application recite every limitation of the application claim, the only differences being that (a) the instant application stores the collected data in a "data file" whereas the '896 application stores its data in a "Raw Data Table", and (b) the instant application discloses that "the performance marker module is executed each time benchmark timestamp data and overhead timestamp data is to be collected", whereas the '896 application discloses that the performance marker module "is executed at predefined points" to collect timestamp data.

There is no functional difference between storing the data in a "data file", as claimed in the instant application, or storing the data in a "Raw Data Table" as claimed

in the '896 application. Similarly, there is no functional difference between executing the performance module marker "each time benchmark timestamp data and overhead timestamp data is to be collected" (instant application) and executing the performance marker "at predefined points" ('896 application), as the "predefined points" ('896 application) would be located where "timestamp data is to be collected" (instant application).

Claim 2, 3 and 5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 4, and 5 of copending Application No. 09/606896 ("the '896 application"), respectively.

Although the conflicting claims are not identical, they are not patentably distinct from each other.

Referring to claim 2, both the instant application (claim 2) and the '896 application (claim 3) disclose an init module for determining if the timestamp data is to be collected.

Referring to claim 3, both the instant application (claim 3) and the '896 application (claim 4) disclose an init module for determining if the timestamp data is to be collected by checking for the existence of an identification key within a system registry, where the identification key uniquely identifies the processing modules to be used to collect, format, and store the run-time internal state data to be collected.

Referring to claim 5, both the instant application (claim 5) and the '896 application (claim 5), disclose a performance marker module which collects timestamp data only if the init module has determined that the timestamp data is to be collected.

Claims 2, 3 and 5 are dependent on claim 1, and therefore the same reasons for obviousness apply. There is no functional difference between storing the data in a "data file" (instant application) or storing the data in a "Raw Data Table" ('896 application).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Allowable Subject Matter***

3. Claims 4 and 6-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. Claims 13-27 are allowed.

5. The following is a statement of reasons for the indication of allowable subject matter:

Claims are allowable over the prior art because, obtaining benchmark timing for a portion of an application program execution by permanently inserting performance markers within an application program, and using an init module to determine if data

should be collected at the performance marker is not found, taught or suggested in the prior art of record.

***Response to Arguments***

6. Applicant's arguments have been fully considered and are persuasive. The prior 35 U.S.C. 102 and 35 U.S.C. 103 rejections with regards to claims 1-27 have been withdrawn.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Kate B Baran whose telephone number is (703)

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305-4474. The examiner can normally be reached on Monday - Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc S Hoff can be reached on (703) 308-1677. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9318.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

MKB

  
MARC S. HOFF  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800